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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,675	12/17/2003	Akira Yoda	3562-0133P	4112
2292	7590	03/03/2009	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				KUCAB, JAMIE R
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,675	YODA, AKIRA	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMIE KUCAB	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 December 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 17 December 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Acknowledgements*

1. Applicant's response filed December 4, 2008 is acknowledged.
2. Claims 1-18 are pending in the application. Claims 1-18 are examined below.
3. This Office action is given Paper No. 20090223 for reference purposes only.
4. Based on a comparison of the PGPub US 2004/0139333 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

### *Drawings*

5. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the authentication processing and information storing apparatus having a personal information storing device, accessible person information storing device, requester authentication device, access level setting device, and personal information output device must be shown or the features canceled from the claims. No new matter should be entered.
6. Corrected drawing sheets in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. §1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o).  
Correction of the following is required:

- a. "device" as recited in claims 1 and 12.
- b. "computer readable medium containing computer executable instructions" as recited in claim 13.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The elements "personal information storing device," "accessible person information storing device," "requester authentication device," "access level setting device," "personal information output device," and "computer readable medium" were not previously disclosed, nor could antecedent basis be found in the specification.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

12. Regarding claims 1 and 12, it is unclear what number of devices are being claimed. The apparatus of claims 1 and 12 includes recitation of at least four devices, however, it appears that the personal information storing device, the accessible person

information storing device, and the requester access level setting device are parts of the same device (see Figs. 2, 6, 8, and 10).

### **Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 7, 9, 10, 11, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Deindl et al. (6,031,910, hereinafter “Deindl”) in view of Houvener et. al. (6,070,141, hereinafter “Houvener”) and further in view of Rankl et al. (*Smart Card Handbook*, 2nd Edition, John Wiley & Sons, Ltd, September 18, 2000. Reference U on the attached form PTO-892. Hereafter, “Rankl”).

15. Regarding claims 1 and 13, Deindl discloses an authentication processing and information storing apparatus (“patient card”) performing requester authentication processing and storing thereon an owner's personal information (C2 L25 - C8 L10), comprising:

- a personal information storing section (file 100) storing thereon the owner's (patient's) personal information (data record 120) which is to be disclosed to a plurality of predetermined accessible persons (“a plurality of users”, C2 L25-32), wherein at least one of the plurality of predetermined accessible persons is someone other than the owner (C2 L25 - C8 L10);

- an access level setting section (“management fields”) setting an access level, which is a level of the personal information to be disclosed to the requester, when said requester authentication section authenticates the requester as the accessible person (C3 L36-54); and
- a personal information output section (READ/WRITE DEVICE 340 in Fig. 3) outputting a part of the personal information stored on said personal information storing section to the requester in accordance with the access level set-up by said access level setting section (C4 L37 - C6 L19).

16. Although Deindl discloses a requester authentication section (“authorization card”, C6 L33-43; user card 310 in Fig. 3 and associated text) and characteristic information (“a surety”, C6 L33-43; “identification feature”, C6 L57- C7 L6) that may be biometric (C6 L33-43), Deindl fails to explicitly disclose:

- an accessible person information storing section storing thereon accessible person characteristic information indicating a physical characteristic of each of the plurality of accessible persons;
- a requester authentication section receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section.

17. However, Houvener teaches:

- an accessible person information storing section (“valid user database”, col. 10 line 40) storing thereon accessible person characteristic information (“first and second ID units”, col. 3 lines 55-56) indicating a physical characteristic (“retinal image”, col. 9 line 20) of each of the plurality of accessible persons;
- a requester authentication section (point of identification terminal 1 in Fig. 1) receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section (Fig. 6A and 6B and associated text).

18. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl to include the accessible person information storing section and requester authentication section of Houvener in order to achieve the predictable result of providing a secure and robust means of biometric authentication.

19. The combination of Deindl/Houvener fails to explicitly disclose wherein if a computed correlation between the requester characteristic information and the accessible person characteristic information is greater than or equal to a predetermined reference value, the requester is authenticated as a predetermined accessible person.

20. If not inherent to Houvener, then Rankl teaches wherein if a computed correlation between the requester characteristic information and the accessible person

characteristic information is greater than or equal to a predetermined reference value ("adjustable identification threshold"), the requester is authenticated as a predetermined accessible person (pp. 390-394).

21. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Deindl/Houvener to include the predetermined reference value of Rankl in order to achieve the predictable result of allowing access to the correct persons while minimizing the number of incorrect authorizations.

22. Deindl/Houvener/Rankl fails to explicitly disclose wherein at least one of the plurality of predetermined accessible persons is someone other than the owner. However, this difference is only found in the nonfunctional descriptive material and does not affect how the claimed invention functions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the combination of Deindl/Houvener/Rankl to include wherein at least one of the plurality of predetermined accessible persons is someone other than the owner, because such descriptive material does not alter how the claimed invention functions.

23. Regarding claim 7, Houvener further discloses wherein said accessible person information storing section stores a plurality of accessible person characteristic information of each of the accessible persons ("first and second ID units", col. 3 lines 55-56), said requester authentication section receives a plurality of requester

characteristic information (steps 220 and 245 in Fig. 6A), and performs authentication processing of the requester using the plurality of accessible person characteristic information and the plurality of requester characteristic information (step 260 in Fig. 6B).

24. Regarding claim 9, Houvener further discloses wherein said requester authentication section employs face information (“retinal image”, col. 9 line 20) as the requester characteristic information and the accessible person characteristic information.

25. Regarding claim 10, Houvener further discloses the apparatus further comprising an image capturing section (“automated comparison system”, col. 9 lines 17-18) for generating the requester characteristic information by capturing an image of the requester.

26. Regarding claim 11, Houvener further discloses wherein said requester authentication section receives the requester characteristic information from a portable apparatus retained by the requester (“smart card”, col. 10 line 29), and said personal information output section outputs the personal information to the portable apparatus retained by the requester and causes the portable apparatus to store the personal information (col. 10 lines 29-30).

27. Claims 2-6, 12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl/Houvener/Rankl and further in view of Schneider et al. (6,105,027).

28. Regarding claims 2, 3, 14, and 15, Deindl/Houvener/Rankl disclose the claimed invention, however, Deindl/Houvener/Rankl fail to explicitly disclose the apparatus

further comprising an access level storing section storing thereon a personal information level, which is a level of the personal information to be disclosed to the accessible person, and an authentication criterion, which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting section determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication section authenticates the requester by the authentication criterion. Schneider et al. teach an access level storing section (Fig. 6) storing thereon a personal information level (“Trust/Data Sensitivity Level” in Fig. 6), which is a level of the personal information to be disclosed to the accessible person, and an authentication criterion (“Minimum Encryption” in Fig. 6), which is strictness of the authentication to be performed when the personal information within the personal information level is disclosed, in association with each other, wherein said access level setting section determines the personal information level corresponding to the authentication criterion as at least a part of the access level when said requester authentication section authenticates the requester by the authentication criterion (col. 18 lines 6-11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl/Houvener/Rankl to include the access level storing section of Schneider et al. in order to provide different levels of access to different users.

29. Regarding claims 4, 5, 16, and 17, Deindl/Houvener/Rankl disclose the claimed invention, however, Deindl/Houvener/Rankl fail to explicitly disclose wherein said

access level storing section stores the plurality of personal information levels and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels, said requester authentication section outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information, and said access level setting section selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication section, and sets the access level to the sum of the selected personal information levels. Schneider et al. disclose an access level storing section that stores the plurality of personal information levels (“Trust/Data Sensitivity Level” in Fig. 6) and also stores a lower limit of credibility of the authentication as the authentication criterion corresponding to each of the personal information levels (“Minimum Authentication” in Fig. 6), said requester authentication section outputs the credibility of the authentication for the requester based on the result of the comparison of the requester characteristic information with the accessible person characteristic information (col. 19 line 55 - col. 20 line 11), and said access level setting section selects the personal information level of which the lower limit of the corresponding credibility is less than the credibility of the authentication output by said requester authentication section, and sets the access level to the sum of the selected personal information levels (col. 19 line 55 - col. 20 line 11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify

the apparatus of Deindl/Houvener/Rankl to include the access level storing section of Schneider et al. in order to provide different levels of access to different users.

30. Regarding claims 6, 12, and 18, Deindl/Houvener/Rankl disclose the claimed invention, but Deindl/Houvener/Rankl fail to explicitly disclose the apparatus further comprising wherein said access level storing section stores the personal information level and the authentication criterion in association with a title of the requester, said requester authentication section further receives the title of the requester from a belonging of the requester, and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing section, and said access level setting section sets the access level to the personal information level corresponding to the title of the requester when said requester authentication section authenticates the requester as the accessible person. Schneider et al. teach an access level storing section (access filter 203 in Fig. 2) that stores the personal information level and the authentication criterion in association with a title of the requester (“UserGroupID” in Fig. 13A), said requester authentication section further receives the title of the requester from a belonging of the requester (“SmartCard” in Fig. 13A), and performs authentication processing of the requester using the authentication criterion by reading the authentication criterion corresponding to the received title from said access level storing section, and said access level setting section sets the access level to the personal information level corresponding to the title of the requester when said requester authentication section authenticates the requester as the accessible person

(col. 35 lines 4-23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Deindl/Houvener/Rankl to include the access level storing section of Schneider et al. in order to more efficiently provide information access to groups of users.

31. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable Deindl in view of Houvener and further in view of Examiner's Official Notice. Deindl/Houvener/Rankl disclose the claimed invention, but Deindl/Houvener/Rankl fail to explicitly disclose that the information storing apparatus is retained by the owner. However, the Examiner takes Official Notice that it is old and well known in the art to make an information storing apparatus portable such that it can be retained by the owner, because this allows individuals to eliminate redundant objects by transporting them from one location to another. It would have been obvious to a person having ordinary skill in the art at the time of invention to make the information storing apparatus portable such that it can be retained by the owner in order to achieve the predictable result of providing the owner of information with control over the security of that information.

#### ***Claim Interpretation***

32. Except where expressly noted otherwise, the Examiner maintains the claim interpretations and definitions of paragraphs 26-30 of the previous Office action (Paper No. 20080116) mailed January 29, 2008.

***Response to Arguments***

33. Applicant's arguments with respect to the §101 rejections of the claims have been fully considered and are persuasive. These §101 rejections of the previous Office action have been withdrawn.

34. Applicant's arguments with regard to the §103 rejections of the claims fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Examiner has, however, provided new grounds of rejection in view of the amendments to the claims.

35. Regarding Applicant's challenge of the Examiner's use of Official Notice, the Examiner respectfully disagrees. MPEP § 2144.03(C) provides the requirements to traverse an Official Notice:

Specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. [emphasis added]

Applicant has failed to adequately traverse the Official Notice because applicant has only made a general allegation that the notice was not proper, in no way addressing why any of the facts would not be common knowledge. Indeed, with no guidance as to why those simple facts officially noticed are not well known, it is impossible to provide a reference addressing Applicant's potential concern. Therefore, according to MPEP § 2144.03(C), the Officially Noticed facts asserted in the previous office action are deemed admitted prior art.

***Conclusion***

36. Applicant's amendment filed December 4, 2008 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

38. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

39. The Examiner has cited particular column, line, and/or paragraph numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider a reference in its entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

40. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

41. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

42. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621